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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Patent Application No. 10/738,396

Applicant: William E. Mazzara Jr. et al.

Filed: December 17, 2003

TC/AU: 2617 (Confirmation No. 7990)

Examiner: VU, MICHAEL T.

Docket No.: 253190 (Client Reference No. GP-304224)

Customer No.: 23460

**TRANSMITTAL OF
APPELLANTS' APPEAL BRIEF**

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 CFR 41.37, appellants hereby submit Appellants' Brief on Appeal.

The items checked below are appropriate:

1. Status of Appellants

This application is on behalf of ☒ other than a small entity or ☐ a small entity.

2. Fee for Filing Brief on Appeal

Pursuant to 37 CFR 41.20(2), the fee for filing the Brief on Appeal is for: ☒ other than a small entity or ☐ a small entity.

3. Oral Hearing

Brief Fee Due \$500.00

☐ Appellants request an oral hearing in accordance with 37 CFR 41.47.

A separate paper requesting oral hearing is attached.

4. Extension of Time

☐ Appellants petition for a one-month extension of time under 37 CFR 1.136, the fee for which is \$ 0.00.

☒ Appellants believe that no extension of time is required. However, this conditional petition is being made to provide for the possibility that appellants have inadvertently overlooked the need for a petition and fee for extension of time.

Extension fee due with this request: \$



5. Total Fee Due

The total fee due is:

Brief on Appeal Fee	\$500.00
Less Brief on Appeal Fee already paid	\$ 0.00
Request for Oral Hearing	\$ 0.00
Extension Fee (if any)	\$ 0.00

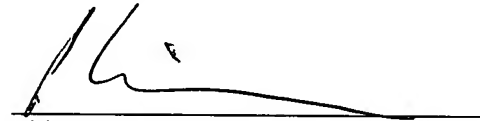
Total Fee Due: \$500.00**6. Fee Payment**

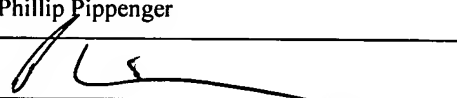
- ☐ Attached is a check in the sum of \$.
- ☒ Charge Account No. 07-0960 the sum of \$500.00. A duplicate of this transmittal is attached.

7. Fee Deficiency.

- ☒ If any additional fee is required in connection with this communication, charge Account No. 07-0960. A duplicate copy of this transmittal is attached.

Respectfully submitted,


Phillip M. Pippenger, Reg. No. 46,055
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza
180 North Stetson Ave., Suite 4900
Chicago, Illinois 60601-6731
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)Date: June 19, 2007

MAILING/TRANSMISSION CERTIFICATE UNDER 37 CFR 1.8 OR 1.10			
I hereby certify that this document and all accompanying documents are, on the date indicated below, being <input type="checkbox"/> deposited with the U.S. Postal Service using "Express Mail" service in an envelope addressed in the same manner indicated on this document with Express Mail Label Number , <input checked="" type="checkbox"/> deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed in the same manner indicated on this document, or <input type="checkbox"/> facsimile transmitted to the U.S. Patent and Trademark Office at fax number: (571) 273-8300.			
Name (Print/Type)	Phillip Pippenger		
Signature		Date	June 19, 2007



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APPELLANT'S APPEAL BRIEF

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P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In support of the appeal from the final rejection dated October 19, 2006,
Appellants now submit their Brief.

Real Party In Interest

The patent application that is the subject of this appeal is assigned to General Motors Corporation, the real party in interest.

Related Appeals and Interferences

There are no appeals or interferences that are related to this appeal.

Status of Claims

Claims 1-20 are pending in the application and stand rejected. Of these, claims 1, 9, 17 and 18 are independent. A copy of the claims is attached at the "Claims Appendix." The rejection of each of the pending claims 1-20 is appealed hereby.

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Status of Amendments

No amendments were submitted subsequent to the Office action presently at issue in this case, and there are no outstanding amendments. Summary of Claimed Subject Matter

The claims are summarized with reference to examples provided in the specification. Claim 1 recites a method for operating a telematics unit (Figure 1, reference 120; figure 2, reference 220; page 11, line 9) within a mobile vehicle (figure 2, reference 210; page 10, line 6) having a radio module (figure 2, reference 290; figure 3, reference 390; page 11, lines 14-17) comprising a radio module user interface (figure 3, reference 393, 395; page 12, line 17-18; page 14, lines 1-7) and includes receiving radio station information at the radio module (figure 4, reference 420; page 15, lines 24-25). The method includes detecting an initiation command received from the radio module user interface (figure 2, reference 290; figure 4, reference 430; page 12, lines 20-21). The method also provides the radio station information (page 11, lines 21-25; page 15, lines 25-29) from the radio module to the telematics unit responsive to the detected initiation command (figure 4, reference 440; page 12, lines 24-26).

Claim 9 recites a computer readable medium (page 11, lines 1-2; page 11, lines 14-15; page 15, lines 19-20) for operating a telematics unit (figure 1, reference 120; figure 2, reference 220; page 11, line 9) within a mobile vehicle (figure 2, reference 210; page 10, line 6) having a radio module (figure 2, reference 290; figure 3, reference 390; page 11, lines 14-17) comprising a radio module user interface (figure 3, reference 393, 395; page 12, line 17-18; page 14, lines 1-7), comprising: computer readable code (figure 2, reference 291; page 11, lines 14-15; page 15, lines 20-22) for sensing received radio station information at the radio module (page 11, lines 15-17; page 12, lines 17-18); computer readable code (figure 2, reference 291; page 11, lines 14-15; page 15, lines 20-22) for detecting an initiation command received from the radio module user interface (figure 4, reference 430; page 12, lines 20-21); and computer readable code (figure 2, reference 291; page 11, lines 14-15; page 15, lines 20-22) for providing the radio station information (page 11, lines 21-25; page 15, lines 25-29) from the radio module to the telematics unit responsive to the detected initiation command (figure 4, reference 440; page 12, lines 24-26).

Claim 17 is presented in a means plus function format in accordance with 35 U.S.C. 112, sixth paragraph, and recites a system for operating a telematics unit (figure 1, reference 120; figure 2, reference 220; page 11, line 9) within a mobile vehicle (figure 2, reference 210; page 10, line 6) having a radio module (figure 2, reference 290; figure 3, reference 390; page

11, lines 14-17) comprising a radio module user interface (figure 3, reference 393, 395; page 12, line 17-18; page 14, lines 1-7). In accordance with 35 U.S.C. 112, sixth paragraph, the system comprises the following means plus function elements: means for (figure 2, reference 290; figure 3, reference 390) receiving radio station information at the radio module (page 11, lines 14-17; page 12, lines 17-18; page 14, lines 8-10); means for (figure 2, reference 290; figure 3, reference 390) detecting an initiation command received from the radio module user interface (figure 4, reference 430; page 12, lines 20-21; page 16, lines 7-8); and means for (figure 2, reference 290; figure 3, reference 390) providing the radio station information (page 11, lines 21-25; page 15, lines 25-29) from the radio module to the telematics unit responsive to the detected initiation command (figure 4, reference 440; page 12, lines 24-26; page 16, lines 14-15).

Claim 18 recites a method for operating a telematics unit (figure 1, reference 120; figure 2, reference 220; page 11, line 9) within a mobile vehicle (figure 2, reference 210; page 10, line 6) having an interactive radio module (figure 2, reference 290; figure 3, reference 390; page 11, lines 14-17; page 14, lines 8-9) comprising a radio module user interface (figure 3, reference 393, 395; page 12, line 17-18; page 14, lines 1-7), the method comprising: receiving radio station information at the interactive radio module (figure 4, reference 420; page 11, lines 14-17; page 12, lines 17-18; page 14, lines 8-10); detecting an initiation command received from the interactive radio module user interface (figure 4, reference 430; page 12, lines 20-21; page 16, lines 7-8); and providing the radio station information (page 11, lines 21-25; page 15, lines 25-29) from the interactive radio module to the telematics unit responsive to the detected initiation command (figure 4, reference 440; page 12, lines 24-26; page 16, lines 14-15) wherein the radio station information is received at the interactive radio module via a sub-carrier band of a radio signal (page 10, lines 17-20; page 12, lines 17-20; page 13, lines 23-30).

Grounds of Rejection to be reviewed on Appeal

Claims 1-4, 6-7, 9-12, 14-15, 17-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,636,489 to Fingerhut (hereinafter "Fingerhut") in view of U.S. Patent No. 6,487,494 to Odinak et al. (hereinafter "Odinak"). Claims 5, 8, 13 and 16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fingerhut and Odinak in further view of U.S. Patent No. 6,711,474 to Treyz et al. (hereinafter "Treyz"). Each of these rejections is appealed.

Argument

All claims presently stand rejected as purportedly obvious in view of the foregoing references as explained above. It is respectfully noted that the cited references, whether taken singly or in any combination, fail to teach the elements of any of the independent claims. A rejection based on prior art cannot be sustained when the cited art fails to teach even one of the claim elements. While the Applicant found it difficult to read and understand the Office Action subject to this appeal, the cited references themselves are quite straightforward and do not lend themselves to the interpretation given in the Office Action. Simply put, the cited references do not teach the limitations for which they are cited. Therefore, it is respectfully requested that the Examiner be instructed to withdraw the pending rejections of claims 1-20.

As stated above, independent claims 1, 9, 17 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fingerhut in view of Odinak. Fingerhut and Odinak, alone or in combination, fail to teach the elements of the independent claims 1, 9, 17 and 18. In particular, the cited paragraphs in Fingerhut do not even vaguely correspond to any of the elements for which they were cited.

The Rejection of Claims 1 and 9 (and dependent Claims 2-8, 20 and 10-16)

Claims 1 and 9 are independent, with claims 2-8, 20 and 10-16, respectively, depending therefrom. Claim 1 pertains to a method for operating a telematics unit within a mobile vehicle having a radio module comprising a radio module user interface. The method entails receiving radio station information at the radio module and detecting an initiation command received from the radio module user interface. Furthermore, the method entails providing the radio station information from the radio module to the telematics unit responsive to the detected initiation command. Claim 9 is similar to claim 1, but it is written in a "computer readable medium" format with "computer readable code" elements for performing the steps included in claim 1. Therefore, the following arguments apply equally to both claim 1 and claim 9.

First, the claims are generally directed to passage of radio station information between a radio module in a mobile vehicle and a telematics unit within the mobile vehicle based on the detection of an initiation command received from the radio module user interface. In contrast, Fingerhut deals with an entirely unrelated problem of over the air activation, deactivation, or change of service for two-way wireless devices, such as pagers or wireless

phones. *See* Fingerhut at col. 1, lines 10-15. Logically, therefore, one would correctly expect that Fingerhut is completely devoid of any mention (express or inherent) related to communication of “radio *station* information,” a “radio module” within a mobile vehicle, or anything else related to radio stations or radio station information. Hence, the term “radio,” as used in Fingerhut is merely a synonym of the term “wireless,” just as the phrase “wireless signal propagation” relates to the term “radio signal propagation,” neither one of which identifies the signal as having information related to a radio *station* or its content. Compare with Application, page 11, lines 21-22:

Examples of radio station information include radio station identification, radio station telephone number, and one or more radio station messages.

Once the above distinction is appreciated, it becomes clear that none of the cited passages in Fingerhut match any of the limitations required by independent claims 1 and 9. Similarly, Odinak deals with *wireless* transmission of *trip* information to and from a vehicle and, therefore, is silent as to communication of radio *station* information between a radio module and a telematics unit of a mobile vehicle. *See* Odinak, col. 1, lines 62-65.

To this end, claim 1 first requires receiving radio station information at the radio module of a mobile vehicle. The Office Action alleges that the Activation Request Packet (Fig. 3) of Fingerhut corresponds to radio station information. While Fingerhut makes it clear that an Activation Request Packet is plainly that - a request to activate service (see, *e.g.*, Fingerhut at col. 3, lines 51-54) and not a communication of radio *station* information as required by claims 1 and 9, there is another problem here. Fingerhut also makes it very clear that the cited packet is received at the network itself, not at the vehicle, let alone at a radio module within a vehicle. *See* Fingerhut at column 3, lines 55-56 (“During the fourth step ...the initial request for activation ... is formed via an activation-request packet (ARP) The fifth step is to **send the ARP from the device to the network.**”)(Emphasis added, reference numbers omitted).

Thus, the rejections cannot be maintained for at least the following reasons:

- The “Activation Request Packet” of Fingerhut in no way corresponds to “radio station information” required by claims 1 and 9. Figure 3 of Fingerhut shows only 5 fields for the ARP, none of which contain radio station information. In response to a request to expressly identify *which* fields of Figure 3 depicting

the format of the Activation Request Packet of Fingerhut correspond to the radio station information in the claims, the Advisory Action fails to refer to any alleged teachings of Fingerhut (express or inherent) and merely points back to the Application itself. *See* Advisory Action, page 2.

- Network 12 of Fingerhut is not a "radio module" within a mobile vehicle as required by claims 1 and 9.
- Fingerhut's "device" is a cell phone or a pager (screen, keypad, etc.), and not a "radio station." *See* Fingerhut at col. 1, lines 12-13. In response to a request to clarify the the Examiner's view that a cell phone can be equated to a radio station, the Advisory Action discusses the *wireless* functionality of device 5 of Fingerhut, such as the fact that it may include a "wireless radio modem." *See* Advisory Action, page 2. A "radio modem" is merely a term of art describing a wireless transceiver. Furthermore, contrary to the assertion of the Advisory Action, none of the cited passages in Fingerhut involve changing AM or FM bands. Specifically, the Advisory Action cites to col. 7, lines 15-17 of Fingerhut, which is silent as to the frequency bands being AM or FM. The frequency band is merely an operational frequency or channel on which the device itself is operating and its change is one of the "changes in service." *See* Fingerhut at col. 7, line 15.

Additionally, claims 1 and 9 require "detecting an initiation command received from the radio module user interface." The Examiner cites the network processing of the ARP as being the required detection of an initiation command from the radio module user interface. *See* Action at page 2. However, the ARP was received from the "device." Thus, at this point, the Examiner is now stating that the device that was previously deemed to be a radio station is now just the opposite, e.g., a radio module of a mobile vehicle, having a user interface. (The action later admits that Fingerhut omits any mention of a user interface; page 3). To the extent it is even understood, this position seems entirely illogical. Therefore, Fingerhut does not teach the "initiation request" of claims 1 and 9. The Applicant was not able to distill from the Office Action or from the Advisory Action where, according to the Examiner, the initiation request was received from. If the initiation request is received from the device the Examiner now appears to be asserting that Fingerhut's cell phone device is both a radio station and a radio module within a mobile vehicle.

Claims 1 and 9 next require "providing the radio station information from the radio module to the telematics unit responsive to the detected initiation command." The Examiner has indicated that the transmission of the ARP response packet back to the device of Fingerhut meets this limitation. However, since the device is already taken for several prior limitations, where now is the required "telematics unit?" The action says that the network and the device together are a telematics unit. *See* Action at page 3. But the device has already been deemed to be a radio station. Therefore, not only is Fingerhut silent as to the required "radio module," but it is also missing the necessary "telematics unit," along with any communication of the "radio station information" between the two in response to detection of an initiation command.

Finally, on page 3 of the Action, the Examiner notes that Fingerhut fails to teach a radio module having a user interface. If Fingerhut fails to teach a radio module, then it necessarily also fails to teach receiving radio station information *at* the radio module, detecting an initiation command received *from* the radio module and providing the radio station information *from* the radio module *to* the telematics unit.

A combination of references cannot make obvious a claim unless each and every element of the claim appears in one reference or the other. Where, as here, every single limitation of the claim is missing from all of the references, a prima facie case of obviousness cannot be made. The above comments apply equally to both claims 1 and 9.

Because Fingerhut and Odinak, alone or in combination, fail to teach any of the elements of independent claims 1 and 9, it is respectfully submitted that these references do not render claims 1 and 9 obvious. Claims 2-8, 20 and 10-16 depend from claims 1 and 9, respectively, and incorporate all of the requirements of their parent claims. Therefore, claims 2-8, 20 and 10-16 are patentable for at least the same reasons as the independent claims from which they depend.

The Rejection of Claim 18 (and dependent Claim 19)

Claim 18 is similar to claims 1 and 9, but further requires that the radio station information is received via a sub-carrier band of a radio signal. The rejection of claim 18 is similar to that of claims 1 and 9, and is traversed for similar reasons. In addition, the rejection of claim 18 includes further subject matter that cannot be understood. For example, the rejection refers to "interfaces" of Figure 4 of Fingerhut, but no such interfaces are

included in the figure. Likewise, the rejection also assumes without any cited support that Fingerhut operates via sub-carrier bands. See Action at page 5. Fingerhut does not mention sub-bands at any point. Although the Applicant requested clarification as to the basis in Fingerhut for the above assertions, the Advisory Action did not provide further explanation.

Therefore, it is respectfully submitted that Fingerhut and Odinak do not render claim 18 obvious because, either alone or in combination, these references fail to teach any of the elements required by this claim. Claim 19 depends from claim 18 and incorporates all of the requirements of its parent claim. Therefore, claim 19 is patentable for at least the same reasons as claim 18.

The Rejection of Claim 17

The remarks above apply with even greater force with respect to claim 17. Moreover, this claim (reproduced below) is plainly drafted in "means-plus-function" format pursuant to 35 U.S.C. §112¶6 ("means for receiving radio station information"; "means for detecting an initiation command"; and "means for providing the radio station information"):

*A system for operating a telematics unit within a mobile vehicle having a radio module comprising a radio module user interface, the system comprising:
means for receiving radio station information at the radio module;
means for detecting an initiation command received from the radio module user interface; and
means for providing the radio station information from the radio module to the telematics unit responsive to the detected initiation command.*

As such, MPEP §2181 expressly requires that the claim be treated according to §112¶6, or that detailed reasons be given as to why such limitations were not treated as means-plus-function limitations. ("[T]he examiner **must** include a statement in the Office action explaining the reasons why a claim limitation which uses the phrase 'means for' or 'step for' is not being treated under 35 U.S.C. §112, sixth paragraph.")(Emphasis added).

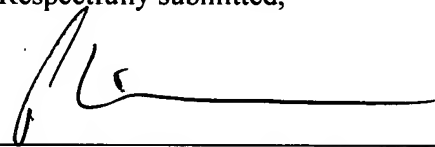
Thus, claim 17 must be treated according to §112¶6 or a detailed analysis must be provided as to why such treatment was not applicable in this case. As such, the Examiner has violated MPEP §2181 and has not presented a prima facie case of obviousness regarding claim 17

Conclusion

In summary, the Action has not presented a prima facie case of obviousness with respect to any of the pending claims 1-20. The cited references, Fingerhut and Odinak, do not teach the limitations for which they were cited.

Because the asserted rejections of claims 1-20 rely on references that simply do not teach the limitations for which they were cited, Applicant respectfully requests that the Examiner be instructed to withdraw the pending rejections of claims 1-20.

Respectfully submitted,



Phillip M. Pippenger, Reg. No. 46,055
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza
180 North Stetson Ave., Suite 4900
Chicago, Illinois 60601-6731
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: June 19, 2007

Claims Appendix

1. (Previously Presented) A method for operating a telematics unit within a mobile vehicle having a radio module comprising a radio module user interface, the method comprising:

receiving radio station information at the radio module;

detecting an initiation command received from the radio module user interface; and

providing the radio station information from the radio module to the telematics unit responsive to the detected initiation command.

2. (Original) The method of claim 1, further comprising:

receiving a communication command; and

initiating a wireless communication via the telematics unit responsive to the received communication command.

3. (Original) The method of claim 2, further comprising:

determining if the initiated wireless communication is connected;

initiating wireless voice communication from a user interface when the initiated wireless communication is connected;

terminating the wireless communication when the initiated wireless communication is not connected; and

reinitializing the terminated wireless communication via the telematics unit responsive to the received communication command.

4. (Original) The method of claim 1, further comprising:

initiating a wireless communication via the telematics unit responsive to the detected initiation command.

5. (Previously Presented) The method of claim 1, wherein the radio station information is selected from the group consisting of: radio station identification, radio station telephone number, one or more radio station messages, alert data, government emergency alerts, weather alerts, sports scores and stock quotes.

6. (Original) The method of claim 1, wherein the radio station information is broadcast on a sub-carrier band.

7. (Previously Presented) The method of claim 1, wherein the radio module user interface is a voice activated user interface.

8. (Previously Presented) The method of claim 1, wherein the radio module user interface is manually operable push button user interface.

9. (Previously Presented) A computer readable medium for operating a telematics unit within a mobile vehicle having a radio module comprising a radio module user interface, comprising:

computer readable code for sensing received radio station information at the radio module;

computer readable code for detecting an initiation command received from the radio module user interface user interface; and

computer readable code for providing the radio station information from the radio module to the telematics unit responsive to the detected initiation command.

10. (Original) The computer readable medium of claim 9, further comprising:

computer readable code for initiating a wireless communication via the telematics unit responsive to a received communication command.

11. (Original) The computer readable medium of claim 10, further comprising:

computer readable code for determining if the initiated wireless communication is connected;

computer readable code for initiating wireless voice communication from a user interface when the initiated wireless communication is connected;

computer readable code for terminating the wireless communication when the initiated wireless communication is not connected; and

computer readable code for reinitializing the terminated wireless communication via the telematics unit responsive to the received communication command.

12. (Original) The computer readable medium of claim 9, further comprising:

computer readable code for initiating a wireless communication via the telematics unit responsive to the detected initiation command.

13. (Previously Presented) The computer readable medium of claim 9, wherein the radio station information is selected from the group consisting of: radio station identification, radio station telephone number, one or more radio station messages, alert data, government emergency alerts, weather alerts, sports scores and stock quotes.

14. (Original) The computer readable medium of claim 9, wherein the radio station information is broadcast on a sub-carrier band.

15. (Previously Presented) The computer readable medium of claim 9, wherein the radio module user interface is a voice activated user interface.

16. (Previously Presented) The computer readable medium claim 9, wherein the radio module user interface is manually operable push button user interface.

17. (Previously Presented) A system for operating a telematics unit within a mobile vehicle having a radio module comprising a radio module user interface, the system comprising:

means for receiving radio station information at the radio module;

means for detecting an initiation command received from the radio module user interface; and

means for providing the radio station information from the radio module to the telematics unit responsive to the detected initiation command.

18. (Previously Presented) A method for operating a telematics unit within a mobile vehicle having an interactive radio module comprising a radio module user interface, the method comprising:

receiving radio station information at the interactive radio module;

detecting an initiation command received from the interactive radio module user interface; and

providing the radio station information from the interactive radio module to the telematics unit responsive to the detected initiation command wherein the radio station information is received at the interactive radio module via a sub-carrier band of a radio signal.

19. (Previously Presented) The method of claim 18 wherein the interactive radio module includes a visual user interface and a physical user interface and is configured to receive commands from the physical user interface and store received radio station information.

20. (Previously Presented) The method of claim 1 wherein the radio station information is received at the radio module via a sub-carrier band of a radio signal, and wherein the radio station information includes a radio station telephone number, and wherein the initiation command is received responsive to a radio station broadcast, and wherein the radio station telephone number is passed to the telematics unit via a communication bus responsive to the initiation command.

Application No. 10/738,396

Appeal Brief

Evidence Appendix

NONE

Application No. 10/738,396

Appeal Brief

Related Proceedings Appendix

NONE